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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,479	01/24/2002	Benjamin A. Bowen	50273/005002	5627

21559 7590 05/06/2003

CLARK & ELBING LLP  
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BOSTON, MA 02110

EXAMINER

SWITZER, JULIET CAROLINE

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/056,479	BOWEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Juliet C. Switzer	1634	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-51 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-26, drawn to methods for identifying a gene associated with a desired phenotype, classified in class 435, subclass 6.
  - II. Claims 27-36, drawn to methods for producing catechin, classified in class 530, subclass 412.
  - III. Claims 37-41, drawn to methods for identifying a compound that increases production of catechin in a cell, classified in class 436, subclass 501.
  - IV. Claims 42-49, drawn to methods of identifying a protein that increases production of a catechin in a cell utilizing gene expression analysis, classified in class 435, subclass 69.1.
  - V. Claims 50-51, drawn to methods for identifying transcripts encoding proteins that catalyze the production of catechin, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to separate methods with distinct goals having different modes of operation and different end results (effects). The methods of group I result in identifying genes associated with desired phenotypes, and utilize steps of contacting cells with stimuli and comparing expression of genes in stimulated cells to cells that were not stimulated. The methods of group II

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are directed towards the production and isolation of catechin. The methods of group III are directed towards isolating compounds that increase catechin production in cells and utilize steps of screening many unknown compounds. The methods of group IV identify proteins that effect catechin production in cells by the expressing the protein heterologously in cells, and the methods of group V identify genes related to catechin production via differential expression analysis of cells that have precursor catechin and cells that have produced catechin.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as demonstrated by their different classification and recognized divergent subject matter and because inventions I-V require different searches that are not coextensive, examination of these claims would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

5. For group I there are distinct species claimed for cell type, phenotype, stimulus and genes, as follows:

Cell type:

- a. plant cells
  - i. *Ajuga reptans* cells
  - ii. *Taxus baccata* cells
  - iii. *C. fascicularis*
  - iv. *C. dejecta*
  - v. *C. barkleyi*

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vi. *C. acinaciformis*

vii. *S. tectorum*

viii. *F. convolvulus*

ix. *R. obtusifolia*

x. *R. sagittatus*

b. animal cells

c. fungal cells

#### Phenotype

a. production of terpenes

b. production of catechin

c. accumulation of catechin

#### Stimulus

a. *Candida*

b. methyl jasmonate

c. zeatin

d. 24-epibrassinolide

e. 1-aminocyclopropane-1-carboxylic acid

#### Gene

a. terpene cyclase

b. galloyltransferase

c. epimerase

d. reductase

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If group I is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic with respect to cell type. Claims 1-2, 5-11, and 14-26 are generic with respect to phenotype. Claims 1-10, 12-25 are generic with respect to stimulus. Claims 1-6 and 10-23 and 25-26 are generic with respect to gene.

6. For group II there are distinct species claimed for cell type:

- d. crassula
- e. falopia
- f. rumex

If group II is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic with respect to cell type.

7. For group IV there are distinct species claimed for protein type:

- g. galloyltransferase
- h. epimerase
- i. reductase

If group IV is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 42-46 and 48-49 are generic with respect to protein.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. A telephone call was made to Paul Clark on 4/24/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet Einsmann Switzer whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Juliet Einsmann Switzer  
Examiner  
Art Unit 1634

May 2, 2003



GARY BENZION, PH.D.  
SUPERVISORY PATENT EXAMINER  
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